

REMARKS/ARGUMENTS

The objection to Claim 1 has been addressed by amending claim 1 in the manner suggested by the Examiner.

Reconsideration of the application is respectfully requested for the following reasons:

Rejection of Claims 1, 2, 5-12, 15, 16, 18, 19, 20-27, 30, 31, 33, 35, 37, 38, 40-47, 50-58, 63, 66-68 and 70 Under 35 U.S.C. §102(e)

Claims 1, 2, 5-12, 15, 16, 18, 19, 20-27, 30, 31, 33, 35, 37, 38, 40-47, 50-58, 63, 66-68 and 70 are rejected under 35 U.S.C. §102(e) as being anticipated by Duphorne et al. (U.S. 6,212,265). In the rejected claims, Claims 1, 20, 40 and 52 are independent.

This rejection is respectfully traversed on the grounds that the Duphorne patent fails to disclose or suggest transforming e-mail **identification information** provided by **an electronic mail provider**, as that term is understood by those skilled in the art, into a **transmission signal** to be transferred to a non-portable receiving terminal, as claimed.

As described in col. 2, lines 18-22 and col. 3, line 60-col. 4, line 31 of Duphorne, the system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. Unlike the claimed e-mail provider, which transforms identification information into a transmission signal and transfers it to the user, the ISP email server is passive, *i.e.*, it performs no transformation. The ISP email server 16a must receive a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in respond to the

query signal. This is in contrast to the claimed method and system, in which the identification information and the transmission signal of new email are created, transformed and then transmitted to a receiving terminal by the email provider or ISP email server.

In order to obtain the claimed invention, it would have been necessary to modify the method and system of Duphorne by omitting the steps of transmitting a query signal to the remote email server and transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network. However, there is no suggestion to do so, and no reason to do so other than the objective of the present invention, namely to notify users of the arrivals of their email without the need of maintaining an online connection.

Although Duphorne discloses that, in some embodiments, the ISP email server 16a automatically transmits the preliminary email notification signal to the central office when email addressed to the user 18 is received by the ISP email server 16a, as the Examiner states in response to Applicants' previous argument, it is a preliminary email notification signal which is sent to the central office when email addressed to the user 18 is received by the ISP email server 16a, not the CallerID-compatible email notification signal. The preliminary email notification signal is then formatted into a CallerID-compatible email notification signal and transmitted to the user 18's email notification device 20 via the local loop 22. In contrast, the identification information of the claimed invention is created and transformed on the electronic mail provider and then is transferred to a non-portable receiving terminal by the same electronic mail provider. Therefore, the teaching of Duphorne is insufficient to render the claimed invention anticipating by one person with ordinary skill in the art and withdrawal of the rejection is respectfully requested.

With respect to claim 20, the Examiner states that Duphorne discloses claim 20 in col. 2 lines 18-22, lines 21-35, col. 8, lines 8-41, col. 4, lines 10-31. However, the email notification signal which the system of Duphorne transmits and receives is a signal in a format compatible with existing CallerID protocols. In other word, the receiving terminal of the system of Duphorne does not need to transform the received email notification signal in a format compatible with existing CallerID protocols because it already is in a format compatible with existing CallerID protocols.

With respect to claim 40, the Duphorne patent does not mention a modulating means for transforming an identification information into a transmission signal. The teaching of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon and, if so, causes an associated Caller ID server of, for instance, the local telephone company to send an email notification signal in a format compatible with existing Caller ID protocols to an email notification device using a public switched telephone network. Because Duphorne sends an email notification signal in a format compatible with existing Caller ID protocols to an email notification device, there is no need of a modulating means for transforming an identification information into a transmission signal.

With respect to claim 52, the Duphorne patent teaches an email notification device for receiving a Caller ID-compatible email notification signal indicating the existence of unread email messages addressed to a user and stored on an email server associated with the user. The email notification device for receiving a Caller ID-compatible email notification signal comprises an input terminal coupled to receive the email notification signal transmitted from a Caller ID server over a

local loop of an associated public switched telephone network, a microprocessor for processing the email notification signal, a memory for storing information associated with the email notification signal, an alert indicating means for alerting the user of receipt of the email notification signal, and the email notification signal representing alphanumeric data related to at least a portion of a text message of one or more email received on the remote email server. The input terminal of Duphorne is coupled to receive the email notification signal transmitted from a Caller ID server while the receiving means of the claimed invention receives a transmission signal which is transferred from an electronic mail provider.

Rejection of Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 Under 35 U.S.C. §103(a)

Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 are rejected under 35 U.S.C. §103(a) as being unpatentable over Duphorne in view of Ozaki (U.S. 5,933,478).

This rejection is respectfully traversed on the grounds that the Ozaki patent, like the Duphorne patent, neither discloses nor suggests an ISP email server that transforms e-mail identification information provided by an electronic mail provider into a transmission signal to be transferred to a non-portable receiving terminal, as claimed.

It is true that the Ozaki patent discloses an active ISP email server which can actively transmit a preliminary email notification signal when a connection between email provider and the receiving terminal is suspended. However, there is no suggestion or teaching that would have suggested modification of the system and method of Duphorne to transform identification information in the manner claimed. Instead, as noted above, Duphorne specifically teaches

that querying the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. Although Duphorne discloses that in some embodiments the ISP email server 16a automatically transmits the preliminary email notification signal to the central office when email addressed to the user 18 is received by the ISP email server 16a, it is merely a preliminary email notification signal which is sent to the central office when email addressed to the user 18 is received by the ISP email server 16a, not the CallerID-compatible email notification signal.

With respect to claim 71, the method of Duphorne provides a user with a Caller ID-compatible email notification signal indicating that email addressed to the user is received at a remote email server associated with the user. The method comprises a step of transmitting a query signal to the remote email server, a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network, a step of formatting the preliminary email notification signal into the Caller ID-compatible email notification signal according to one or more parameter values, and a step of transmitting the Caller ID-compatible email notification signal from the central office to the user using the public switched telephone network. Even though Ozaki discloses suspending a connection between a email provider and the receiving terminal when no response message is received within a predetermined period, the combination of Duphorne and Ozaki would not have resulted in the claimed invention since the system and method of Duphorne already queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon at first.

With respect to claims 17, 32, 39 and 69, although Clayton (U.S. 5,875,234) discloses that the UART format is typically used for Caller ID services and Huna teaches a switch device for controlling

operation the receiving terminal respectively, the respective teachings of Clayton and Huna do not disclose the elements of the claimed invention which the teaching of Duphorne does not mention. The combinations of Duphorne and Clayton as well as Duphorne and Huna are not sufficient to render the claimed invention prima facie obvious.

Conclusion

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to read 'B. Urcia', with a long horizontal line extending to the right.

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